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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/914,192   | 10/31/2001  | Humio Inaba          | 0020-4893P          | 9467             |
| 2292   | 7590        | 03/05/2004           | EXAMINER            |                  |
| BIRCH STEWART KOLASCH & BIRCH<br>PO BOX 747<br>FALLS CHURCH, VA 22040-0747 |             |                      | PAIK, STEVE S       |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2876                |                  |
| DATE MAILED: 03/05/2004  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/914,192

**Applicant(s)**

INABA ET AL.

**Examiner**

Steven S. Paik

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Receipt is acknowledged of the Amendment filed December 16, 2003. The amendment includes amended claims 1, 6, and 8 and a newly added claim 12.

***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on February 25, 1999. It is noted, however, that applicant has not filed a certified copy of the JP11/47995 application as required by 35 U.S.C. 119(b). This National State application should include the copy of the certified copy of the abovementioned priority document. Such copy is respectfully requested as a response to this Office Action.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soules et al. (U.S. Patent 5,522,623) in view of Rudland (U.S. Patent 4,538,059).

Re claims 1-4, Soules discloses an information carrier medium (10 in Fig. 1 or 20 in Fig. 2) comprising:

at least first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22. Also there is disclosed an intermediate coded layer between the upper and lower laminae.)

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each having first and second surfaces opposite to each other (top and rear faces), said first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22) being laminated together (Abstract and see col. 5, lines 65, 66 and col. 6, lines 13) with the first surface of the first sheet member bonded to the first surface of the second sheet member (the top face of the second member is supporting the intermediate coded layer);

a security indicium (a barcode 13, a finger print 16, a barcode 23, or a barcode 26) formed on at least one of the first faces of the respective first and second sheet members, said security indicium being made of at least one inking material for responding to a coherent light (col. 9, Table I discloses various combinations of sources, appropriate detectors and the optical response) when irradiated thereby. It is well known in the art that coherent light includes a nitrogen laser, a xenon laser, an argon ion laser, and ionized neon laser. Soules teaches an IR or UV laser beam as one of various light sources in column 9, lines 5-39. A barcode reading procedure includes differentiating the amount of light absorbed and reflected from the code printed by an inking material when irradiated by a light source (col. 6, lines 43-56). Hence, the inking material used to print the barcode or fingerprint in Soules is also considered to absorb the coherent light, emit light, and scatter light when irradiated by the coherent light (col. 11, ll. 36-42) with a predetermined wavelength.

However, Soules is silent about an overlay film integrated with an outer surface of the at least first and second sheet members laminated together and a magnetic strip layered on an outer surface.

Rudland discloses an identification card or badge with a concealed code, which, while being invisible to the naked eye when viewed in visible light, is readable by an optoelectronic

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reader using infrared radiation. The code further comprises successive digits represented by transparent windows alternating with regions opaque to infrared radiation. The card comprises two sheets (2 and 4) with a code sheet (6) laminated with a transparent protective layer of PVC or other similar clear plastic (9). A magnetic strip and a space for a specimen signature, as is usual with such cards for the purpose of increasing authenticity of the cardholder.

In view of Rudland teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further incorporate an identification card with an overlay film such as a transparent protective layer of PVC or other similar clear plastics with a magnetic strip and a space for a specimen signature in addition to the teachings of Soules due to the fact that authenticity and security of the card usage can be substantially improved for the purposes of preventing fraudulent activities. Furthermore, such modification of employing an overlay film with a magnetic strip to the teachings of Soules would have been an obvious matter of design variation, well within the ordinary skill in the art, and therefore an obvious expedient.

Re claims 5 and 9-11, Soules in view of Rudland discloses the information carrier medium (10 in Fig. 1, 20 in Fig. 2 or 30 in Fig. 3) recited as rejected claim 1 stated above, where the security indicium (a barcode 13, a finger print 16, a barcode 23, or a barcode 26) formed on such one of the first surfaces of the respective first and second sheet members (upper lamina 11 or 21 and lower lamina 12 or 22. Also there is disclosed an intermediate coded layer between the upper and lower laminae, and the top face of the second member is supporting the intermediate coded layer.) is visible to naked eyes (col. 6, lines 41-43 teaches the code may or may not be visible to the human eye).

Re claim 12, Soules in view of Rudland discloses the information carrier medium (10 in Fig. 1, 20 in Fig. 2 or 30 in Fig. 3) recited as rejected claim 1 stated above, wherein said at least first and second sheet members are made of an opaque synthetic resin containing a polyvinyl chloride copolymer as a principal component, and said overlay film is made of a hard polyvinylchloride (col. 3, ll. 3-14 of Rudland reference).

5. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soules et al. (U.S. Patent 5,522,623) as modified by Rudland (U.S. Patent 4,538,059) as applied to claim 1 above, and further in view of Sano et al. (U.S. Patent 5,971,276).

Re claims 6-8, the teachings of Soules in view of Rudland have been discussed above. Soules discloses an information carrier medium and a reading system of the medium. Rudland discloses an example of ink or print material for the security indicium (col. 3, ll. 30-37).

Although Soules in view of Rudland discloses a reading device (electro-optical reading means in col. 6, ll. 43-56), the references do not specifically disclose each of the claimed elements of the reading means.

Sano teaches a method and apparatus for reading a code pattern including a light source (11) to illuminate a portion (2) of the information medium (1) in register with the security indicium; and a photo detector means (12 in Fig. 1) for detecting rays of light obtained from that portion of the information carrier medium; and a detecting means (an image analyzer 54, i.e. computer and a monitor 53) connected to the photo-detector (see Fig. 6) for comparing output from the photo-detector with a reference signal stored therein to verify an authenticity of the information carrier medium.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further combine a pattern or code reading device including a light source, a photo-detector, and an analyzer, as taught by Sano with the information carrier medium of Soules in view of Rudland due to the fact that more selective and precise detection of wavelengths and transmission of the detected wavelengths can be achieved through a filter and a photo-detector. As a result of such modification of employing a pattern/code reader to the information carrier medium of Soules in view of Rudland, more precise and secure reading of the pattern would be achieved.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

The newly added limitations in claims 1, 6, and 8 are rejected in view of new ground of rejection under 35 U.S.C. § 103(a). Soules et al. (U.S. Patent 5,522,623) in view of Rudland (U.S. Patent 4,538,059) reads on the claims set forth in the present application.

Accordingly, claims 1-12 remain rejected.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven S. Paik  
Examiner  
Art Unit 2876

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